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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,943	03/08/2000	ANDREW E FANO	AND1P525	1143

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EXAMINER

VAN DOREN, BETH

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/520,943

Applicant(s)

FANO ET AL.

Examiner

Beth Van Doren

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—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 03 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 21-49.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 15, 16

10. ☐ Other: _____

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Advisory Action

This advisory action is in response to the communications received on 03/03/04.

In the remarks, Applicants argues that (1) Jones et al. (U.S. 6,021,397) fails to teach and suggest the effect of the projected goal upon other goals (i.e. a plurality of goals and the interrelational effect of each goal on every other goal specified by the user), (2) that personal goals and financial goals are not equivalent and personal goals are not necessarily a type of financial goals, (3) as per claim 35, it is not common knowledge to alert providers remotely of financial products of unenrollment, considering such transactions occur directly with providers and this has no bearing on the claim wince a provider is notified that its product is suggested to the user when the user modifies a preference, (4) as per claim 38, while it may be common knowledge to tailor ad banners through stored user preferences, this common knowledge is not applicable because the claim describes a banner ad displayed based on matched offerings, and (5) as per claim 47, while it may be common knowledge for an individual to account for insurance expenses when determining cash flow, this common knowledge is not applicable because the system presents an option to the user that constitutes insurance, the obtaining of insurance being a method by which the user may obtain a defined goal (i.e. presenting insurance provider information is not for the purpose of determining cash flow).

In response to argument (1) of the Applicant, Examiner respectfully disagrees. Examiner asserts that Jones et al. does teach this idea when it discusses the multiple goals of one's life (such as retirement age, purchasing a home, sending a child to college, money saving and money investing plans, etc.) being accounted for in the system and

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allowing the user to set ages, amounts, etc. of what is preferred, as stated in column 4, lines 7-33, column 5, lines 50-67, column 6, lines 7-34 and 40-45. The system runs these preferences and goals and informs the user as to his/her ability to meet the goals with the current settings. Then, through an iterative process, the user can change settings and see the outcome of these changes. See also column 10, lines 60-66, which discusses further intermediate goals of a user.

In response to argument (2) of the Applicant, Examiner points out that independent claim 21 recites “a plurality of goals”, “goal”, at least one goal”, “one of the goals”, “remaining goals”, and “goals”. Nowhere in these recitations does claim 21 specify what type the goals of the system must be. Only claim 22 recites that the goals are financial goals and only claims 23 and 37 recite types of goals, all of which are disclosed in Jones et al. in at least column 4, lines 10-34, and column 6, lines 13-40 and 50-58. Since the claims do not exclude personal “goals”, since financial goals would be personal goals if the financial goals concern the finances of a specific person, and since personal goals and financial goals would be equivalent when being objectively balanced, Examiner respectfully disagrees with the Applicant.

In response to arguments (3)-(5), Examiner points out that the limitations argued are not expressly recited in the claims (i.e. unenrollment, displaying banner ads based on the offerings, using insurance to obtain a defined goal, etc.). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner suggests that if these features are essential to the novelty of the claimed invention that they be clearly recited in the limitations of the claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882. The examiner can normally be reached on M-F, 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



bvd

March 8, 2004



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